

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re PATENT application of:

Applicant: Harry H. Lu

Application No.: 10/702,225

Filing Date: November 5, 2003

Title: DUNNAGE CONVERTER WITH COILER AND MECHANICAL
SECUREMENT DEVICE

Examiner: Eugene Lee Kim

Art Unit: 3721

Atty. Docket No. RANPP0348USA

REPLY BRIEF

MS Appeal
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This brief is submitted in support of the appeal of the decision of the Examiner mailed July 14, 2005 and in response to the Examiner's Answer mailed May 18, 2006.

In response to Applicant's arguments, the Examiner has taken the position that there is no recitation in the claims that imparts the sequential order asserted by Appellant in distinguishing Fuss (U.S. Patent No. 5,468,556). In particular, the Examiner has taken the position that he does not have to consider language in the claims related to function rather than structure. See Examiner's Answer, page 6.

Consequently, the Examiner appears to be reading claim 1 in the following manner.

1. A system, comprising a dunnage supply having a converter that is ~~operable to convert a sheet stock material into a strip of relatively less dense dunnage, the dunnage supply having an outlet through which one or more of the strips of dunnage are supplied, a positioning device that positions in juxtaposition portions of the one or more strips of dunnage, and a stapler for connecting the juxtaposed portions to hold them together~~

The Examiner concludes that Fuss discloses all of the elements of the system and thus anticipates the claim.

The struck-through text in claim 1 reproduced above is necessary for understanding the relationship of the structural elements in the claimed system, and thus must be considered by the Examiner. See M.P.E.P. §2173.05(g). The functional language provides the arrangement of elements that distinguishes the claimed system from the system described in Fuss.

In the claimed system, the dunnage supply includes a converter, an outlet, a positioning device and a stapler. Admittedly, each element by itself is known. Their arrangement in the claimed system, however, is new and is not obvious in view of the

into a strip of relatively less dense dunnage. Dunnage strips are supplied through the outlet. Thus, the outlet must be at a downstream end of or downstream of the converter. The positioning device positions in juxtaposition portions of the strips of dunnage. The positioning device cannot position portions of the strips unless it also is downstream of the converter. Finally, the stapler can connect the juxtaposed portions to hold them together. The stapler cannot connect juxtaposed portions unless the positioning device has positioned those portions of the dunnage strip(s) next to each other. The stapler thus must be at or downstream of the positioning device and consequently must be downstream of the converter as well. In summary, the converter must convert a sheet stock material into a strip of relatively less dense dunnage before (and thus upstream of) the positioning device can juxtaposition portions of the strips of dunnage and before the stapler can connect those positioned portions to hold them together.

As noted in the Appeal Brief, Fuss's strips 96 are not less dense than the stock material 60 from which they are formed. Once the convoluted non-planar shape 20 is formed, Fuss does not juxtaposition or staple juxtaposed portions of those relatively less dense dunnage products. The Examiner admits as much saying "Fuss, et al. do not specifically show a coil or the stapling arrangement as claimed." Examiner's Answer, p. 4.

With regard to Cruz (U.S. Patent No. 6, 251, 054), the Examiner has taken the position that Cruz discloses maximizing efficiency in the use of space by providing a curved path upon which sheet stock material is fed for stapling multiple layers to form a booklet. The Examiner argues that this claim to maximizing space efficiency is motivation for combining the teachings of Cruz with those of Fuss.

Cruz feeds multiple flat sheets along a curved path and then staples the sheets together half way along the path, before moving the sheets back out of the curved path from the way they entered that path. The staples hold the sheets together, but do not hold them in a less dense shape. Cruz clearly does not coil the sheets and then staple them to maintain their coiled configuration, for example.

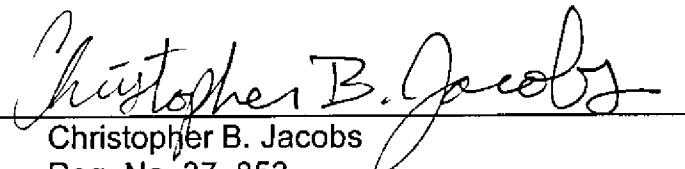
In addition, it is respectfully submitted that the hypothetical person of ordinary skill in the field of Fuss would not know how to apply these teachings of Cruz to the making of Fuss's convoluted non-planar-shape loose-fill packaging particles 20. Consequently, even if a person of ordinary skill in the art did consider Fuss and Cruz together, there is no basis for determining how Fuss could provide a curved path to minimize space and thereby increase the efficiency of the production process. Even if the skilled person was motivated to combine the teachings of Fuss and Cruz, it is not clear how that leads to the claimed system. It is respectfully submitted that it would not, and the claimed system would not have been obvious in view of the combination of Fuss and Cruz.

The other reference cited by the Examiner in combination with Fuss is Wischusen (U.S. Patent No. 5, 643, 647). Wischusen discloses a loose fill dunnage element having a similar shape to that produced by Fuss, although with a jagged edge and a non-linear shape prior to the folding process. Wischusen does not disclose its manufacturing apparatus, and does nothing to address the deficiencies of Fuss described above.

Accordingly, the final rejection is improper and should be reversed.

A credit card payment form is enclosed herewith for payment of the fees for filing this brief. No extension of time is believed to be necessary. If an extension of time is needed to make the filing of this paper timely, however, and no separate petition is attached, please consider this a petition for the requisite extension. In the event any additional fee is due in connection with the filing of this paper, the Commissioner is authorized to charge those fees to our Deposit Account No. 18-0988 (under the above Docket Number).

Respectfully submitted,
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